UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

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LONZA INC., Plaintiff, v. NALCO COMPANY, Defendant.	Civil Action No. 09-04635 (JLL-CCC) Honorable Jose L. Linares, U.S.D.J Honorable Claire C. Cecchi, U.S.M.J. Motion Date: September 19, 2011

NALCO COMPANY'S OPPOSITION TO LONZA INC.'S
MOTION FOR PARTIAL RECONSIDERATION OF CLAIM CONSTRUCTION

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Introduction

In its Motion for Reconsideration, Lonza merely restates its original arguments, recasts cases it has already presented and raises spurious new arguments that are not relevant to its Motion and could have been raised during claim construction. "L.Civ.R. 7.1(i) does not allow parties to recapitulate cases and arguments which the court has already considered before rendering its original decision." *Grimes v. Ricci*, 2011 U.S. Dist. LEXIS 92370, 5-8 (D.N.J. Aug. 18, 2011) (J. Linares) (citing *G-69 v. Degnan*, 748 F. Supp. 274, 275 (D.N.J. 1990)); *see also Schering Corp. v. Mylan Pharms.*, 2011 U.S. Dist. LEXIS 84679 (D.N.J. Aug. 1, 2011) (J. Linares) (denying a motion for reconsideration of claim construction where the moving party merely restated its previous arguments). "Thus, a difference of opinion with the court's decision should be dealt with through the normal appellate process." *Id.* In its opening and responsive claim construction briefs, Lonza focused its "consisting essentially of" argument around *PPG Indus. v. Guardian Indus. Corp.* (*See* Dkt. No. 43 at 14-15, Dkt. No. 47 at 24-25) (citing *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351 (Fed. Cir. 1998)). At the *Markman* hearing, Lonza's presentation regarding this term began with citations to *PPG*. (*See* Lonza April 21, 2011 Claim Construction Presentation at Slide 49). The Court's Order regarding this term dealt specifically with Lonza's arguments under *PPG* and even quoted the relevant language from that case. (*See* Dkt. No. 64 at 9). Yet, Lonza premises its Motion for Reconsideration on its assertion that the Court somehow "overlooked" *PPG*. (*See* Lonza's Motion, Dkt. No. 65 at 3-5).

Lonza merely rehashes thoroughly presented arguments that were considered and rejected by the Court. Indeed, Lonza admits that the Court already considered the issues presented for reconsideration. (*See* Lonza's Motion at 3-5). Lonza's restatement of the same arguments in a more drawn out manner does not come close to justifying reconsideration – "an extraordinary remedy [that] should be granted 'very sparingly.'" *See Sprint Spectrum L.P. v. Zoning Bd. of Adjustment*, 2011 U.S. Dist. LEXIS 5791 (D.N.J. Jan. 19, 2011) (citing L. Civ. R. 7.1(i) cmt.6(d)).

Lonza's asserts that "no case law exists to support [the Court's] conclusion." (Dkt. No. 65 at 4-5). Yet, the Court clearly set forth a cardinal Federal Circuit claim construction maxim in support of its construction – *i.e.*, "[i]n construing the terms of a patent, a court should look first to the language of the claim itself." (*See* Dkt. No. 64 at 2 citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). The Court applied this fundamental rule throughout its analysis. (*See* Dkt. No. 64 at 8-9 (". . .when read in the context of the claim at issue . . . given its placement within the claim, 'consisting essentially of' modifies only the last clause")). Further, Lonza incorrectly asserts that the Court's construction conflicts with Federal Circuit precedent. (*See* Lonza's Motion at 4-9). In the cases cited by Lonza, the parties did not dispute whether "consisting essentially of" modified the asserted claims as a whole or a particular clause of the claim. Accordingly, in those cases, the Federal Circuit did not address the present issue. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those [claim] terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

Argument

I. The Court Did Not Overlook Lonza's Arguments Or Commit Clear Legal Error In Its Construction Of The Phrase "a mixture consisting essentially of the slimicide and the N-hydrogen compound."

Local Civil Rule 7.1(i), which governs Lonza's motion, provides that it shall be confined to "matter[s] or controlling decisions which the party believes the Judge or Magistrate Judge has overlooked." "The word 'overlooked' is the dominant term, meaning that except in cases where there is a need to correct a clear error or manifest injustice, only dispositive factual matters and controlling decisions of law which were presented to the court but not considered on the original motion may be the subject of a motion for reconsideration." *See Leja v. Schmidt Mfg.*, 743 F. Supp. 2d 444, 456 (D.N.J. 2010). Further, "a decision suffers from 'clear error' only if the record cannot support the findings that led to that ruling. *Id*. (citing *United States v. Grap*e, 549 F.3d 591, 603-04 (3d Cir. 2008)). "Thus, a party must do more than allege that portions of a ruling were erroneous in order to obtain reconsideration of that ruling; it must demonstrate that (1) the holdings on which it bases its request were without support in the record, or (2) would result in 'manifest injustice' if not addressed. *Id*. (citing *Grape*, 549 F.3d at 603-04). Mere "disagreement with the Court's decision" does not suffice. *Id*. (citing *P. Schoenfeld Asset Mgmt., LLC v. Cendant Corp.*, 161 F. Supp.2d 349, 353 (D.N.J. 2001)). Moreover, "[i]n the context of a motion to reconsider, the term 'manifest injustice' 'generally means that the Court overlooked some dispositive factual or legal matter that was presented to it, making the definition an overlap with the prime basis for reconsideration . . . that is, the need 'to correct manifest errors of law or fact upon which the judgment was based.'" *See In re Telfair*, 745 F. Supp. 2d 536, 561 (D.N.J. 2010) (quoting *In re Rose*, 2007 U.S. Dist. LEXIS 64622, at *3 (D.N.J. Aug. 30, 2007).

As the Court made clear, its claim construction is supported by the language of the claim itself. (*See* Dkt. No. 64); s*ee also Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1347 (Fed. Cir. 2008) ("this court does not interpret claim terms in a vacuum, devoid of the context of the claim as a whole"); *see also Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999) ("proper claim construction . . . demands interpretation of the entire claim in context, not a single element in isolation."); *see also ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) ("While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered"). The three Federal Circuit cases cited by Lonza merely support the argument that Lonza already made in both of its claim construction briefs and at the hearing. (Compare Lonza's Motion at 3-9 with Dkt. No. 43 at 14-15 and Dkt. No. 47 at 24-25). In view of the Court's well supported construction, Lonza's disagreements – premised on the same case law the Court already considered – do not come close to warranting reconsideration. Nonetheless, as shown below, none of the three cases cited by Lonza even attempted to resolve the dispute at issue. Moreover, a closer look at the case law cited by Lonza reveals that this case is ripe for summary judgment against Lonza regardless of the Court's construction.

A. *PPG Indus. v. Guardian Indus. Corp.*

PPG was the focal point of the parties' dispute during claim construction. The Court considered Lonza's arguments regarding *PPG* and rejected them:

> In PPG Industries v. Guardian Industries Corp. the term "consisting essentially of," when read in the context of the claim at issue, is used at the beginning of the claim and, therefore, serves as the transition phrase for the entire claim. Here, the term "consisting essentially of" is not used as a transition phrase at the beginning of the claim, but rather at the end of the body of the claim. Logically, given its placement within the claim, "consisting essentially of" modifies only the last clause and, therefore, its construction must be limited to that clause.

(Dkt. No. 64 at 9). In *PPG*, the parties did not dispute whether "consisting essentially of" applied to the claim as a whole or an element of the claim. *See PPG Indus.*, 156 F.3d at 1354. Rather, the dispute revolved around whether the Court should have construed the claim to determine whether certain ingredients have "a material effect on the basic and novel properties of the glass" as a matter of law. *Id.* at 1354-55. In fact, the construction given to the jury by the District Court – which was affirmed by the Federal Circuit – did not even include reference to "the basic and novel characteristics of the invention" as Lonza would suggest, but instead referred to the "material effect on the basic and novel properties of the glass." Moreover, the structure of the claim in *PPG* was far different than the structure of the claim asserted by Lonza. The Court was correct to look first to the language of the claim at issue to construe the disputed term rather than to blindly accept Lonza's proposed construction that was based on dicta related to claim construction of the completely unrelated *PPG* patent from a case where the construction of "consisting essentially of" was not the same as Lonza's proposed construction. *See Vitronics Corp.*, 90 F.3d at 1582.

B. *AK Steel Corp. v. Sollac and Ugine*

As in *PPG*, the parties in *AK Steel* did not dispute whether "consisting essentially of" applied to the claim as a whole or an element of the claim. *See AK Steel Corp. v. Sollac and Ugine*, 344 F.3d 1234, 1239-41 (Fed. Cir. 2003). Rather they disputed whether the Court's construction should, as a matter of law, specifically limit the claim based on certain ingredients' "material effect on the ***aluminum coating bath*** and the resultant coated steel." *Id*. at 1240 (emphasis added). Indeed, while the Court stated the general rule that "consisting essentially of" relates to the "invention," it applied the "materially effect" language to the "aluminum coating bath," an element of the invention like the mixture in this case. *Id*. The Court also specifically referenced the necessity of examining the intrinsic record on a case by case basis to determine the proper scope and construction of the disputed term. *Id*.

Lonza made its *AK Steel* arguments during claim construction briefing. (*See* Dkt. 47 at 24-25). Although the Court did not cite AK Steel in its Order, "[t]he fact that an issue was not explicitly mentioned by the court does not on its own entail that the court overlooked the matter in its initial consideration." *See Morton v. Fauver*, 2011 U.S. Dist. LEXIS 85805 (D.N.J. July 21, 2011) (citing *Ashton v. AT&T Corp.*, No. 03-3158, 2006 U.S. Dist. LEXIS 4787, at *5 (D.N.J. Feb. 2, 2006).

C. *Water Technologies Corp. v. Calco Ltd.*

Like *PPG* and *AK Steel*, in *Water Technologies* the parties did not dispute and the Court did not need to determine whether the term "consisting essentially of" should apply to a specific element of the claim. *See Water Technologies Corp. v. Calco Ltd.*, 850 F.2d 660 (Fed. Cir. 1988). Lonza did not raise this case previously, the Court could not have overlooked it and the Court should not consider it now. Nonetheless, Lonza's arguments related to *Water Technologies Corp.* are no different than the arguments it previously raised with respect to *PPG* and *AK Steel*. Lonza's Motion fails to explain how this case differs from its previous arguments or how it is evidence of clear error or a manifest injustice. (See Lonza's Motion at 8-9).

D. The Court Should Consider The Cases Cited By Lonza When It Determines Whether Certain Ingredients Materially Affect The Mixture.

Lonza's restatement of its previous arguments does not provide grounds for reconsideration. It does, however, bring to light Federal Circuit precedent that if the intrinsic record is clear, the Court should, as a matter of law, determine whether certain disclaimed additional ingredients materially affect the mixture or invention. *See AK Steel Corp.*, 344 F.3d at 1239-41. Here, for example, the patent specification and prosecution history explicitly state that a solution "buffer" is not part of the invention or claimed mixture. The intrinsic record – in a response to a PTO office action – goes so far as to distinguish the prior art based on the absence of a "buffer":

> Further, buffer addition is not required. Indeed, buffered, prepared solutions, which are the essence of Golton, ***are not a part of the current application***.

(March 29, 1996 Amendment in response to December 27, 1995 Office Action, LONZA00066-00067, attached as Exhibit A) (emphasis added). Thus, if the Court modifies its construction in any way, it should make clear that addition of a buffer materially affects the basic and novel properties of the mixture and the invention. *See AK Steel Corp.*, 344 F.3d at 1239-41. To this end, regardless of the parties' dispute over "consisting essentially of," any process that includes a buffer cannot infringe as a matter of law. Accordingly, if there is no dispute of material fact regarding the addition of a buffer in the accused process, this case should end on summary judgment regardless of whether "consisting essentially of" applies to the invention as a whole or the claimed mixture.

II. Lonza's Additional Arguments

Aside from rearguing Federal Circuit case law, Lonza's Motion makes three arguments – none of which are appropriate under Local Rule 7.1(i). Indeed, Lonza does not even attempt to explain how any of these arguments were "overlooked" or otherwise appropriate bases for reconsideration. *See Leja*, 743 F. Supp. 2d at 456.

A. The Claimed Mixture Is Unquestionably Part Of This Case.

Lonza's argument that the Court's construction "requires analysis of invention(s) not in this case" makes little sense. (*See* Lonza's Motion at 9-10). The claimed "mixture" is unquestionably part of this case because it is an element of the asserted claim. In order to prove infringement, Lonza must demonstrate that every element of the asserted claim is practiced by an infringer. *See Becton, Dickinson & Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1253 (Fed. Cir. 2010) ("To establish literal infringement, 'every limitation set forth in a claim must be found in an accused product, exactly.'"). Regardless of the Court's construction, the mixture and its characteristics are indispensable to the issues in this case. If the Court cannot determine whether certain ingredients have an effect on the basic and novel properties of the "mixture" based on the intrinsic evidence alone, the issue will be decided by a jury as in *PPG*. *See PPG Indus.*, 156 F.3d at 1354-55 ("after the court has defined the claim with whatever specificity and precision is warranted by the language of the claim and the evidence bearing on the proper construction, the task of determining whether the construed claim reads on the accused product is for the finder of fact"). Lonza's displeasure with the issues remaining in the case is not grounds for reconsideration.

B. *Church & Dwight* Is Not Precedent and Was Already Considered.

Lonza does not assert *Church & Dwight Co., Inc. v. Abbott Laboratories* as grounds for reconsideration because it is not precedent. (*See* Lonza's Motion at 10-13). Further, in *Church & Dwight*, the Court was not faced with the present issue. *See Church & Dwight Co., Inc. v. Abbott Laboratories* 2008 U.S. Dist. LEXIS 49587, *10-11 (D.N.J. June 23, 2008). In *Church & Dwight*, the Court was not asked to determine whether "consisting essentially of" modifies and applies to the term "solution" or to the entirety of claim. *Id*. Indeed, the proposed constructions for "solution consisting essentially of said conjugate" from *Church & Dwight* highlight the difference from this case: Church & Dwight's construction: "a solution including the conjugate and any other materials that do not materially affect the basic and novel properties of the invention"; Abbott's construction: "Conjugate in a solution that does not contain a meta-soluble material or other chromatographic transport agent." (*See* Case No. 05-cv-02142, Dkt. No. 78, June 25, 2007 Claim Construction Brief at p. 30, Attached as Exhibit B). The claim construction dispute from *Church & Dwight* was inapposite when Lonza first argued it during claim construction, and certainly should not impact the present decision.

III. Nalco's Interrogatory Responses Are Consistent With Its Construction.

Lonza fails to explain how Nalco's Interrogatory Responses are relevant to its Motion. Lonza had them in its possession throughout claim construction and never argued that Nalco made an admission of any kind with respect to this term. Accordingly, they cannot be used in support of Lonza's Motion. Regardless, the excerpt set forth in Lonza's Motion indicates that

"Nalco incorporates its answer to Interrogatory No. 4 as if fully set forth herein. (*See* Lonza's Motion, Exhibit 1 at p. 5). Nalco's answer to Interrogatory No. 4 makes clear that "[t]he use of the caustic substance in the Nalco OxiPRO Program, therefore, materially affects the ***basic and novel characteristics of the mixture*** of the bleach and urea claimed in the '021 Patent." (*See* Exhibit C) (emphasis added). Thus, Nalco's Interrogatory answers make clear that under any construction of the "consisting essentially of" term, Nalco does not infringe. Lonza's inclusion of one of Nalco's alternate non-infringement theories and omission of the language that was clearly incorporated by reference is a cheap attempt to give the Court something to consider other than redundant case law citations already considered by the Court.

Conclusion

For the above reasons and the reasons set forth above, Nalco respectfully requests this Court to deny Lonza's Motion for Reconsideration.

Dated: September 6, 2011

Respectfully submitted,

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LONZA, INC., Plaintiff, vs. NALCO COMPANY, Defendant.	Civ. Action No.: 09-04635 (JLL-CCC) Honorable Jose L. Linares, U.S.D.J. Honorable Claire C. Cecchi, U.S.M.J. **CERTIFICATE OF SERVICE**

I hereby certify that, on the date listed below, I caused the foregoing **Nalco Company's Opposition to Lonza Inc.'s Motion for Partial Reconsideration of Claim Construction** with attached exhibits A through C to be served on the following individual by electronic service:

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By:/s/Justin A. Greenblum________
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Dated: September 6, 2011